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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,685	03/09/2001	Gary Van Nest	377882001600	9970

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MORRISON & FOERSTER LLP
755 PAGE MILL RD
PALO ALTO, CA 94304-1018

EXAMINER

WOITACH, JOSEPH T

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 04/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/802,685

Applicant(s)
Nest et al.

Examiner
Joseph Weitach

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1632



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 9, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-10 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

This application filed March 9, 2001, claims benefit to provisional application 60/188,302, filed March 10, 2000.

Applicants' amendment filed December 26, 2001, paper number 6, has been received and entered. The specification has been amended.

It is noted that claims 9 and 10 are duplicates of claims 3 and 4, respectively. Claim 8 is drawn to itself ("The method of claim 8"), however for the sake of compact prosecution is being interpreted to the method set forth independent claim 1. Accordingly, claim 8 as interpreted is a duplicate of claim 2.

Claims 1-10 are pending.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 5, 6 and 7, drawn to a method of reducing severity of a symptom of a virus infection by administering the ISS 5'-C, G, pyr, pyr, C, G-3', and a kit containing said ISS sequence, classified in class 514, subclass 44.
- II. Claims 2 and 8, drawn to a method of reducing severity of a symptom of a virus infection by administering the ISS 5'-pur, pur, C, G, pyr, pyr, C, G-3', classified in class 514, subclass 44.

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- III. Claims 3 and 9, drawn to a method of reducing severity of a symptom of a virus infection by administering the ISS 5'-AACGTTCG-3', classified in class 514, subclass 44.
- IV. Claims 3 and 9, drawn to a method of reducing severity of a symptom of a virus infection by administering the ISS 5'-GACGTTCG-3', classified in class 514, subclass 44.
- V. Claims 4 and 10, drawn to a method of reducing severity of a symptom of a virus infection by administering the ISS 5'-TGACTGTGAACGTTCGAGATGA-3', classified in class 514, subclass 44.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II-V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed. The sequence recited in claim 1 is smaller than those set forth in dependent claims, however because of the open language the sequence of claim 1 can comprise the larger sequences specifically set forth in the dependent claims. The inventions are distinct because the sequence set forth in claim 1 can be used by itself and does not require, for example, the particular addition of two additional purines at the 5' end as set forth in claim 2. Similarly, claims 3 and 4 set forth

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specific subcombinations of the sequence encompassed by claim 1 and the particulars of these sequences are not required to practice the method of claim 1. The subcombination has separate utility such as ISS sequences which can be administered for other types of infections, or instead of being administered alone as set forth in claim 1 can be provide with other antigens.

Inventions II-V are related as subcombinations. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, each of the ISS sequences of the inventions have separate utility because they are provided individually in practicing the method set forth in claim 1. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II-V, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (703)305-3732.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at (703)305-4051.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group analyst Dianiece Jacobs whose telephone number is (703) 308-2141.

Papers related to this application may be submitted by facsimile transmission. Papers should be faxed via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center numbers are (703)308-4242 and (703)305-3014.

Joseph T. Woitach


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